

## Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
<b>SERIAL NUMBER</b>	85455577
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 105
<b>MARK SECTION (no change)</b>	
<b>ARGUMENT(S)</b>	
Please see the actual argument text attached within the Evidence section.	
<b>EVIDENCE SECTION</b>	
<b>EVIDENCE FILE NAME(S)</b>	
<b>ORIGINAL PDF FILE</b>	<a href="#">evi_7497462-140919300_.Strategic_Snacking_Class_9_Final_OA_Resp.pdf</a>
<b>CONVERTED PDF FILE(S)</b> (7 pages)	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\854\555\85455577\xml4\RFR0002.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\854\555\85455577\xml4\RFR0003.JPG</a>
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<b>SIGNATURE SECTION</b>	
<b>RESPONSE SIGNATURE</b>	/Mary Sotis/
<b>SIGNATORY'S NAME</b>	Mary Sotis
<b>SIGNATORY'S POSITION</b>	Attorney of record, New York bar member
<b>SIGNATORY'S PHONE NUMBER</b>	212-980-0120
<b>DATE SIGNED</b>	02/11/2013
<b>AUTHORIZED</b>	

<b>SIGNATORY</b>	YES
<b>CONCURRENT APPEAL NOTICE FILED</b>	YES
<b>FILING INFORMATION SECTION</b>	
<b>SUBMIT DATE</b>	Mon Feb 11 14:17:38 EST 2013
<b>TEAS STAMP</b>	USPTO/RFR-74.9.74.62-2013 0211141738426607-85455577 -5002a1a142453a7a8e2f4415 dc8a46b5efdb8aeb78d378893 787c2e43af7e0-N/A-N/A-201 30211140919300091

PTO Form 1930 (Rev 9/2007)  
OMB No. 0651-0050 (Exp. 4/30/2009)

## Request for Reconsideration after Final Action To the Commissioner for Trademarks:

Application serial no. **85455577** has been amended as follows:

### ARGUMENT(S)

**In response to the substantive refusal(s), please note the following:**

Please see the actual argument text attached within the Evidence section.

### EVIDENCE

#### Original PDF file:

[evi\\_7497462-140919300\\_. Strategic Snacking Class 9 Final OA Resp.pdf](#)

**Converted PDF file(s)** (7 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

[Evidence-6](#)

[Evidence-7](#)

### SIGNATURE(S)

#### Request for Reconsideration Signature

Signature: /Mary Sotis/ Date: 02/11/2013

Signatory's Name: Mary Sotis

Signatory's Position: Attorney of record, New York bar member

Signatory's Phone Number: 212-980-0120

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 85455577

Internet Transmission Date: Mon Feb 11 14:17:38 EST 2013

TEAS Stamp: USPTO/RFR-74.9.74.62-2013021114173842660

7-85455577-5002a1a142453a7a8e2f4415dc8a4

6b5efdb8aeb78d378893787c2e43af7e0-N/A-N/

A-20130211140919300091

UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No. : 85455577  
Mark : STRATEGIC SNACKING  
Class : 009  
Applicant : SBD Holdings Group Corp.  
Filed : October 25, 2011  
Law Office : 105  
Trademark Attorney : Tasneem Hussain

**Request for Reconsideration**

This submission is in response to the Final Office Action issued on August 27, 2012 (the “Office Action”) with respect to the above-captioned mark. Applicant SBD Holdings Group Corp. (“Applicant”) seeks to register the mark STRATEGIC SNACKING (“Applicant’s Mark” owned by “Applicant”) in International Class 009 for “*prerecorded video tapes, audio tapes, CD-ROMs, DVDs, computer software and downloadable software in the nature of a mobile application featuring information on recipes, meal planning, exercise, nutrition, health and lifestyle; computer software and downloadable software in the nature of a mobile application for generating shopping lists, meal planning, menu planning, devising personalized nutrition programs and nutrition diaries.*” The Examining Attorney made final the refusal to register under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that the mark merely describes Applicant’s goods. Applicant respectfully requests reconsideration of this refusal to register.

## **ARGUMENT**

### **A. STRATEGIC SNACKING is Suggestive of Applicant's Goods**

It is the Trademark Office's burden to prove that a mark is merely descriptive. Applicant respectfully submits that the Examining Attorney has not met that task. The Examining Attorney sets forth the definitions of "strategic" and "snacking." From this, the Examining Attorney concludes that STRATEGIC SNACKING describes "prerecorded video tapes, audio tapes, CD-ROMs, DVDs, computer software and downloadable software in the nature of a mobile application featuring information on recipes, meal planning, exercise, nutrition, health and lifestyle; computer software and downloadable software in the nature of a mobile application for generating shopping lists, meal planning, menu planning, devising personalized nutrition programs and nutrition diaries." Further, the Examining Attorney asserts that "strategic snacking" is the subject matter of Applicant's goods and that "a term that describes the subject matter of a publication is merely descriptive under Trademark Act 2(e)(1)." However, Applicant propounds that Applicant's STRATEGIC SNACKING goods are healthy lifestyle tools that are only suggested by the mark STRATEGIC SNACKING.

Section 2(e)(1) of the Trademark Act prohibits registration of a mark that is merely descriptive. However, a suggestive mark may be registered. "Whether a given mark is suggestive or merely descriptive depends on whether the mark 'immediately conveys ... knowledge of the ingredients, qualities, or characteristics of the goods ... with which it is used', or whether 'imagination, thought or perception is required to reach a conclusion on the nature of the goods'." *In re Gyulay*, 820 F.2d 1216 (Fed. Cir. 1987). It is widely recognized that there is only a thin line of distinction between a suggestive and a merely descriptive mark, and that it is often difficult to determine when a term moves from suggestiveness into the realm of descriptiveness. *In re Recovery, Inc.*, 196 USPQ 830 (TTAB 1977).

Although a consumer could determine how Applicant's mark was chosen by looking into the definitions of the words in Applicant's Mark, those definitions alone do not prove that the mark is descriptive. STRATEGIC SNACKING does not directly or immediately convey information about Applicant's healthy lifestyle tools and diet program, much less CDs, DVDs, or a mobile application. It takes a mental pause to combine the definitions of "strategic" and "snacking" and conclude that the mark suggests planning snacks for health benefits, and another pause to see how that would fit with CDs and DVDs with information on recipes, meal planning, exercise, nutrition, health and lifestyle or a mobile application that allows consumers to generate shopping lists, plan meals, plan menus, and devise personalized nutrition programs and nutrition diaries. These pauses or "mental hiccups" are enough to put Applicant's Mark on the suggestive side of the descriptiveness/suggestiveness line. See *In re Crocker National Bank*, 223 USPQ 152 (TTAB 1984)(WORKING CAPITAL not merely descriptive of banking services because it has no precise meaning when applied to banking services); *In re Southern National Bank of North Carolina*, 219 USPQ 1231 (TTAB 1983) (MONEY 24 not descriptive of automatic teller machine services); *Rand McNally & Co. v. Christmas Club*, 242 F.2d 776 (C.C.P.A. 1957) (holding that the mark CHRISTMAS CLUB was not merely descriptive of a magazine which contained matter advertising Christmas clubs). As is made clear by Applicant's broad recitation in Class 009, "planning snacks" is only a de minimis building block of the overall lifestyle and diet tools that Applicant will provide under STRATEGIC SNACKING.

As such, STRATEGIC SNACKING is suggestive of Applicant's goods. STRATEGIC SNACKING, as it is used in connection with Applicant's goods, lacks the immediacy and significance required for a descriptiveness determination under trademark law. See *In re Hutchinson Technology*, 852 F.2d 552, 554 (Fed. Cir. 1988). "STRATEGIC SNACKING" is not the common descriptive name of the goods, or the features of the goods, listed in

Applicant's application, i.e. CDs, DVDs, software and mobile applications with information on recipes, exercise, health, and lifestyle, etc. Since consumers must pause and draw conclusions to determine the nature of the goods, Applicant's Mark is suggestive, not merely descriptive. See *AMF Inc.*, 599 F.2d at 349; *In re Tennis in the Round, Inc.*, 199 U.S.P.Q. at 497.

**B. The Evidence Provided by the Examining Attorney is Not Persuasive of Descriptiveness**

An analysis of the internet evidence provided by the Examining Attorney as support for the 2(e)(1) refusal does not bear out the conclusion that Applicant's Mark is merely descriptive. The Examining Attorney attaches material from Applicant's website regarding Applicant's use of "strategic snacking." The Examining Attorney suggests that since Applicant describes the term "strategic snacking" on its website, Applicant's use of STRATEGIC SNACKING in relation to the goods as set forth in Applicant's application Serial No. 85455577 will be descriptive. Logically, this does not follow. Applicant's application was filed on an "intent to use" basis. As such, Applicant's use of the term on its website has no bearing on whether STRATEGIC SNACKING is descriptive of CDs, DVDs, and a mobile application, or whether Applicant's future use of the term will be descriptive. If anything, the fact that Applicant has to describe the term "strategic snacking" on Applicant's website to Applicant's consumer indicates that the term will not be perceived by Applicant's consumer as readily knowable and descriptive.

Moreover, the internet evidence provided by the Examining Attorney does not prove that "strategic snacking" has one particular meaning to consumers, nor that STRATEGIC SNACKING will be immediately perceived by consumers as referring to Applicant's goods. The internet evidence (nine articles and internet pages dating from 1996 to 2012) does not show the term used at all with Applicant's goods (CDs, DVDs, or a mobile application). Moreover,

the nine instances of internet use provided by the Examining Attorney do not prove that STRATEGIC SNACKING would be commonly known in the industry to describe Applicant's goods. The only conclusion that can be drawn by the Examining Attorney's evidence is that the combined words "strategic snacking" have been used nine times over the course of the last seventeen years by third-parties. Additionally, the internet evidence does not prove that "strategic snacking" has one particular meaning to consumers: looking closely at each page provided by the Examining Attorney reveals that the term "strategic snacking" is used differently in each article:

- In the article appearing on Cbsnews.com, "strategic snacking" is used to refer to a concept that eating between meals may help seniors over the age of 65 *consume sufficient calories*, as "older adults tend to get fewer calories and may need snacks to make up their calorie deficit."
- The page printed from the University of Waterloo uses Strategic Snacking in a trademark sense (not descriptively as the Examining Attorney asserts) as the title of a university food services nutrition workshop.
- The article printed from Fullengagementtraining.com discusses a theory of how snacking can decrease fatigue as snacking relates to an individual's glycemic index.
- The article from Yahoo.com discusses tips on how to generally avoid snacking and/or to choose the best snacks in order to *eat less* over the course of a day.
- The article from Thefastertimes.com titled "Strategic Snacking for New Year's Eve" discusses how to *snack throughout an evening of drinking* so that individuals do not wake up on New Year's Day with a hangover or "worshipping the porcelain god."



- The article provided from Carbohydrate-guide.com discusses a study by MIT wherein serotonin levels were linked to weight gain and further discusses a diet plan by one of the researchers called the “Good Mood Diet” that encourages a habit of snacking to control mood and serotonin levels.
- The article from the Chicago Tribune discusses how *athletes* need to rethink their between-meals eating habits in order to have the greatest amount of energy for their games and workouts.
- The screen print from the website Drannwellness.com does not, as far as Applicant can tell, even use the term “strategic snacking.”
- Finally, the article provided from the Evansville Courier & Press website uses the term “strategic snacking” as the title for a brief article on healthy snack options.

As such, these articles do not prove that “strategic snacking” has one particular meaning to consumers, nor that STRATEGIC SNACKING will be immediately perceived by consumers as meaning CDs and DVDs that provide information on recipes, meal planning, exercise, nutrition, health and lifestyle, or a mobile application for generating shopping lists, meal planning, menu planning, and devising personalized nutrition programs and nutrition diaries.

**C. All Doubts Must Be Resolved In Favor of the Applicant**

Finally, it is well established practice that where, at the examining stage, any doubts at all exist regarding whether a mark is “merely descriptive,” those doubts must be resolved in favor of the applicant and the mark should be permitted to proceed to publication. See *In re Shop-Vac Corp.*, 219 U.S.P.Q. 470, 472 (T.T.A.B. 1983) (“At the very least ... we have doubts about the ‘merely descriptive’ character of the mark before us and, unlike the situation in determining likelihood of confusion ... it is clear that such doubts are to be resolved in favor of applicants.”); *In re Morton-Norwich Products, Inc.*, 209 U.S.P.Q. 791, 791 (T.T.A.B. 1981)

(noting that the Board's practice is "to resolve doubts in applicant's favor and publish the mark for opposition."); *In re Atavio Inc.*, 25 U.S.P.Q.2d 1361 (T.T.A.B. 1992); *In re Vernon Chatman III*, 2009 TTAB Serial Nos. 77261141 and 77261143, not precedential (noting that the issue of descriptiveness is to be resolved in favor of the applicant in ex parte proceedings, unlike inter parties proceedings). At a minimum, there is sufficient basis for doubt about whether Applicant's Mark is merely descriptive to warrant passing the mark to publication.

### **Conclusion**

For the reasons stated above, Applicant submits that STRATEGIC SNACKING does not merely describe its proposed goods, and, accordingly, requests that the mark be approved for publication.

Dated: New York, New York  
February 11, 2013

Respectfully Submitted,

FRANKFURT KURNIT KLEIN & SELZ, P.C.



By: \_\_\_\_\_

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